

REMARKS/ARGUMENTS

I. STATUS OF CLAIMS

Claims 1-30 remain in this application. Claim 22 was previously amended. Applicant has amended Claims 1, 11-16, and 29. It should be noted that Applicant has elected to amend said Claims solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals, 65 Fed. Reg. 54603 (9/8/00). In making this amendment, Applicant has not and does not in any way narrow the scope of protection to which Applicant considers the invention herein to be entitled and does not concede, in any way, that the subject matter of such Claims was in fact taught or disclosed by the cited prior art. Rather, Applicant reserves Applicant's right to pursue such protection at a later point in time and merely seeks to pursue protection for the subject matter presented in this submission.

II. CLAIM REJECTIONS – 35 U.S.C. § 103

The Office Action rejected Claims 1-2, 4-17, 19-25 and 28-30 under 35 U.S.C. § 103(a) as being unpatentable over Beranek et al. (6,226,642) in view of Kavner (6,366,947). The rejection is respectfully traversed.

Claims 1, 11-16, and 29 have been amended to clarify the invention. Claim 1 appears as follows:

1. A method of optimizing retrieval of electronic documents, comprising the computer-implemented steps of:
receiving a first electronic document;

identifying one or more symbolic references to other electronic documents within the first electronic document;
determining a network address of each of the other electronic documents corresponding to each of the symbolic references;
creating and storing on a cache server a modified copy of the first electronic document in which the network address is substituted for each corresponding symbolic reference;
delivering the modified copy of the electronic document in response to all subsequent client requests for the first electronic document.

In particular, Beranek does not teach or disclose a system that provides identifying one or more symbolic references to other electronic documents within the first electronic document, determining a network address of each of the other electronic documents corresponding to each of the symbolic references, and creating and storing on a cache server a modified copy of the first electronic document in which the network address is substituted for each corresponding symbolic reference as claimed in Claim 1. Beranek teaches away from such a system by teaching that a client system contains a caching proxy that reformats Web documents and stores reformatted Web documents on a local cache on the client. Col. 2, lines 50-53 state:

“It is a more specific object of the invention to enhance the operation of a Web appliance by using a local proxy to dynamically re-format information received from a Web server.”

This is further stated in Beranek in Figs. 3, 4; col. 2, lines 63-67; col. 3, lines 11-34; col. 8, line 60-col. 9, line 25; col. 10, lines 21-27; col. 11, line 62-col. 12, line 61; and throughout the reference.

Additionally, Kavner teaches away from such a system by teaching that a local cache is used to store a previously accessed Web page (Abstract; col. 4, lines 44-59; col. 5, lines 16-29; col. 11, line 37-col. 12, line 43; and throughout the reference).

Further, the Office Action misquotes a claimed element by stating (emphasis added): “creating and storing a modified copy of the first electronic document in which a **substitution** is made for each corresponding symbolic reference ...”. This statement is incorrect. The claimed element in Claim 1 is (emphasis added): “creating and storing on a cache server a modified copy of the first electronic document in which **the network address is substituted for each corresponding symbolic reference**”. The Office Action has changed the language of the claimed element. The Office Action then states that Beranek teaches a substitution by “the caching proxy 225 is used to add links, modify links, to add or modify scripts, etc.”. However, Beranek does not teach or disclose substituting the network address for each corresponding symbolic reference. Beranek makes no mention of performing such a substitution.

The Office Action additionally misquotes another claimed element by stating: “... and delivering the modified copy of the electronic document in response to all subsequent requests for the first electronic document ...”. The actual claimed element in Claim 1 is (emphasis added): “delivering the modified copy of the electronic document in response to all subsequent **client** requests for the first electronic document”. Beranek teaches away from the claimed element by teaching that a client system contains a local cache and retrieves re-formatted Web pages from its cache.

The Office Action states that it would have been obvious to one of ordinary skill in the art at the time of the invention was made to: “... have Beranek determine/retrieve the network TCP/IP address for each of the symbolic references and save it locally, as

taught by Kavner ... in order to more speedily retrieve the information at a subsequent time”. However, Kavner specifically states in col. 3, line 31-col. 4, line 59 that a local cache of Web pages is provided **“in order to more speedily present data to a user”**. Given Kavner’s statement, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to follow Kavner’s teachings and modify Beranek to locally cache Web pages in order to more speedily retrieve the Web pages at a subsequent time.

Therefore, the Office Action’s rationale for combining Beranek and Kavner does not support the Office Action’s conclusion.

Further, the Office Action’s statement: “have Beranek determine/retrieve the network TCP/IP address for each of the symbolic references and save it locally” is not what is claimed in Claim 1, which states:

“creating and storing on a cache server a modified copy of the first electronic document in which the network address is substituted for each corresponding symbolic reference;”

Therefore, the Office Action’s result of combining Beranek and Kavner is not what is claimed in Claim 1.

Therefore, Beranek in view of Kavner does not teach or disclose the invention as claimed.

Claim 1 is allowable. Independent Claims 11-16 and 29 are similarly allowable - Claim 12 cites a router. Claims 2, 4-10, and 28 are dependent upon Claim 1 and are allowable. Claims 19-25 and 27 are dependent upon Claim 16 and are allowable. Claim 30 is dependent upon Claim 29 and is allowable. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

III. CLAIM REJECTIONS – 35 U.S.C. § 103

The Office Action rejected Claims 3, 18 and 26-27 under 35 U.S.C. § 103(a) as being unpatentable over Beranek et al. (6,226,642) in view of Kavner (6,366,947), as applied to claims 1 and 16 above, and further in view of Admitted Prior Art (APA).

The rejection under 35 USC §103(a) is deemed moot in view of Applicant's comments regarding Claims 1, 11-16 and 29, above. Claims 3 and 26 are dependent upon Independent Claim 1. Claims 18 and 27 are dependent upon Independent Claim 16. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 USC §103(a).

IV. MISCELLANEOUS

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

The Applicants believe that all issues raised in the Office Action have been addressed and that allowance of the pending claims is appropriate. Entry of the amendments herein and further examination on the merits are respectfully requested.


The Examiner is invited to telephone the undersigned at (408) 414-1214 to discuss any issue that may advance prosecution.

No fee is believed to be due specifically in connection with this Reply. To the extent necessary, Applicants petition for an extension of time under 37 C.F.R. § 1.136. The Commissioner is authorized to charge any fee that may be due in connection with this Reply to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Dated: December 16, 2004


Kirk D. Wong
Reg. No. 43,284

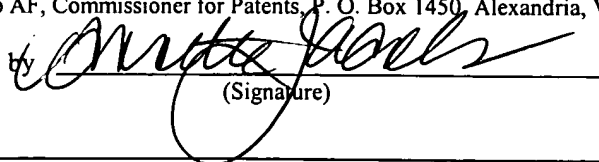
1600 Willow Street
San Jose, California 95125-5106
Telephone No.: (408) 414-1080 ext. 214
Facsimile No.: (408) 414-1076

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

on December 16, 2004
(Date)

by


(Signature)